

REMARKS

Please reconsider the application in view of the above amendments and the following remarks. Applicant thanks the Examiner for carefully considering this application.

Disposition of Claims

Claims 1-55 were pending in this application. Claims 3-20, 24-39, and 43-55 have been withdrawn by the Examiner. Claims 1 and 40 have been amended in this response. No new matter has been added by way of these amendments, which are supported at least in Figs. 15-17 of the application as filed.

Rejections under 35 U.S.C § 103

Claims 1-2 and 40-42 stand rejected under 35 U.S.C. § 103 as obvious over U.S. Patent No. 6,092,314, issued to Rothbart ("Rothbart"). Claims 1 and 40 have been amended in this reply to clarify the present invention recited. To the extent that this rejection may still apply to the amended claims, the rejection is respectfully traversed.

Amended claim 1 recites an orthopedic appliance comprising a wedge for placement beneath a toe and *forward of the center of a first metatarsal*, and having a first upper surface disposed between an apex and a first end, and a second upper surface disposed between an apex and a second end, wherein the first upper surface is disposed at an angle of inclination relative to the lower planar surface in a direction substantially parallel to the medial column of the foot, whereby *a distal end of a proximal phalanx is raised with respect to a distal end of the first metatarsal*. In contrast to such a device,

Rothbart discloses a forefoot support surface having a back edge positioned **posterior to the first metatarsal but anterior to a plantar surface of the calcaneus** (Col. 6, ll. 30-32). This location is well outside of the location of a wedge according to claim 1 of the current application. Furthermore, the forefoot support device according to Rothbart is configured to cause an angle of inclination across the medial column of the foot (i.e., in the transverse plane), and not in a direction that is parallel to the medial column of the foot (i.e., in the sagittal plane), as required by the instant invention. In contrast to Rothbart, the invention of claim 1 raises a distal end of a proximal phalanx with respect to a distal end of a first metatarsal, thereby advantageously facilitating plantarflexion of the first metatarsal through the late midstance and propulsive phases of gait (Paragraph 66 of the current application). The invention according to Rothbart instead elevates the first metatarsal and does not allow the biomechanical action (described above) that is an advantage of the instant invention. Therefore, withdrawal of this rejection with respect to claim 1, as well as claim 2 which depends from claim 1, is respectfully requested.

Claim 40, as amended, recites a method for improving stability of the foot comprising providing a wedge ***forward of the center of a first metatarsal***, said wedge having a first and second upper surface, and ***elevating a proximal phalanx relative to a first metatarsal***. In contrast, Rothbart discloses a forefoot support system **extending from the hallux to proximal to (past) the first metatarsal head** (Col. 6, ll. 24-25, 33-37 and Fig. 6). Furthermore, the forefoot support system according to Rothbart elevates the medial column of the forefoot relative to the remainder of the forefoot (i.e. the angle of inclination according to Rothbart is across the foot, i.e., in the transverse plane) as indicated by the fact that the Rothbart device "does not significantly elevate the

phalanges 47 of the second toe” (Col. 6, ll. 41-42) while supporting the medial column of the forefoot in an elevated position relative to the remainder of the forefoot (Col. 6, ll. 57-58). Thus, Rothbart supports the entire medial column relative to the rest of the forefoot (i.e. inclination is across the foot), in contrast to the support method of claim 40 that elevates a proximal phalanx relative to a first metatarsal (i.e. inclination is parallel to the foot).

Furthermore, Applicant fails to discern the Examiner’s basis for the statement that the Rothbart device “elevates a proximal phalanx to a predetermined angle of inclination using the wedge, relative to a first metatarsal” (Office Action at p. 3). Neither the specification nor the figures of Rothbart suggest any such functionality. In view of these distinctions claim 40, and claims 41-42 which depend from claim 40, are patently distinct over Rothbart. Accordingly, withdrawal of this rejection is respectfully requested.

Claims 21-23 stand rejected under 35 § 103 as obvious over “Rothbart ‘134”. Applicant is not aware of a Rothbart ‘134 reference. Applicant respectfully requests clarification of the reference cited, and also requests withdrawal of the finality of the current Office Action, so that Applicant may ascertain which Rothbart reference was intended by the Examiner. Until further clarification is received by Applicant, arguments will be based on the assumption that the Rothbart ‘314 patent was the intended reference. Accordingly this rejection is respectfully traversed.

Claim 21 recites an apparatus for orthopedic treatment comprising a support which maintains the proximal phalanx at an angle of inclination *relative to a first metatarsal*. As previously discussed with regard to claim 40, above, Rothbart discloses a

forefoot support system extending from the hallux to proximal to (past) the first metatarsal head (See Col. 6, ll. 24-25, 33-37 and Fig. 6). Accordingly, the forefoot support system elevates the medial column of the forefoot relative to the remainder of the forefoot. Thus, the biomechanical basis of the Rothbart device is contrary to that of the current invention, which advantageously allows for retrograde plantarflexion of the first metatarsal head.


Applicant fails to discern the Examiner's basis for the statement that the Rothbart device "maintains the proximal phalanx at an angle of inclination... relative to a first metatarsal" (Office Action at p. 3). Although the Examiner references Col. 6, ll. 66-67, Col. 7, ll. 1-19, and Fig. 10, none of these contain a relevant disclosure. Col. 6, ll. 66-67 discusses a **downward slope** of the upper surface of the foot support system. Col. 7, ll. 1-19 discuss various configurations of the foot support system, none of which relate to an **inclination** of a proximal phalanx relative to a first metatarsal. Finally, Fig. 10 is a **cross-section** of the foot support system (see Col. 3, ll. 5-8) and therefore cannot possibly disclose an angle of inclination **along the medial column of the foot**. In fact, there is no suggestion in the specification or figures of Rothbart of a device which maintains the proximal phalanx at an angle of *inclination relative to a first metatarsal*. Instead, Rothbart supports the entire medial column relative to the rest of the forefoot. For at least these reasons, claim 21 is patentable over Rothbart. Claims 22-23, which depend from claim 21, are similarly patentable. Accordingly, withdrawal of this rejection is respectfully requested.

Conclusion

Applicant believes this reply is fully responsive to all outstanding issues and places this application in condition for allowance. If this belief is incorrect, or other issues arise, the Examiner is encouraged to contact the undersigned or his associates at the telephone number listed below. Please apply any charges not covered, or any credits, to Deposit Account 50-0591 (Reference Number 09166.002002).

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Respectfully submitted,


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Jila M. Mohandesi

Group Art Unit

3728Invention: **ORTHOPEDIC SHOE APPLIANCE AND METHOD**

I hereby certify that the following correspondence:

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